



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,385	02/18/2004	Satoshi Mizutani	20050/0200895-US0	3573

7278 7590 12/06/2006

DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

EXAMINER

BOGART, MICHAEL G

ART UNIT	PAPER NUMBER
----------	--------------

3761

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,385

Applicant(s)

MIZUTANI ET AL.

Examiner

Michael G. Bogart

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-12,20 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-12,20 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07 November 2006.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 1, 23 and 24 are objected to because of the following informalities:

Claim 1 recites the limitation "the back side sheet" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claim 23 recites the limitation "the other sheet piece" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "the other sheet" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 recites the limitation "back sheet" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 24 does not end in a period.

Appropriate correction is required.

Claim Rejections

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 25 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which

Art Unit: 3761

it is most nearly connected, to make and/or use the invention. There is no description in the application as originally filed of adhesive applied in a Ω -form.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1, 6-9, 12, 20 and 23-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Champaigne, Jr. (US 3,665,923).

Regarding claim 1, Champaigne, Jr. teaches a pad comprising:

A surface side sheet (14) having a permeable property for liquid;

A plurality of sheet pieces forming a back face side sheet (14, 20) and including a sheet piece having one end that overlaps another sheet piece;

Art Unit: 3761

An absorbent body (12) for absorbing liquid and enclosed between the surface side sheet (14) and the back face side sheet (14, 20); and

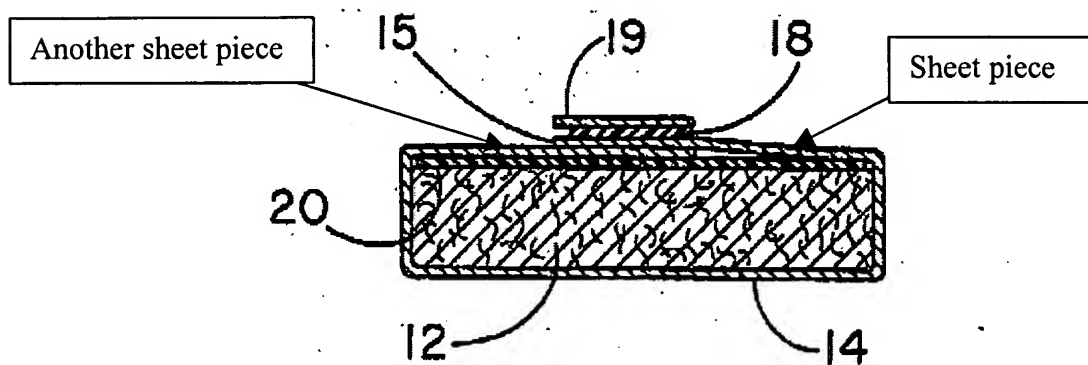
At least one seam part (15) formed by overlapping the plurality of sheet pieces over one another, the seam part including

A longitudinal seam part (15) extending in a longitudinal direction of the pad, crossing over the back side sheet (14, 20) from an edge (16) to another edge of the back face side sheet (14, 20), and

An adhesive agent (18) applied between the sheet piece the other sheet piece at the longitudinal seam part (15) along the longitudinal central line,

Wherein the sheet piece which overlaps the another sheet piece at the longitudinal seam part (15) and which covers a side closer to a longitudinal central line of the pad, is positioned at the absorbent body side of the back side sheet (14, 20),

Wherein the surface side sheet (14) and the back face side sheet (14, 20) are joined at a peripheral edge of the absorbent body (14)(col. 2, lines 43-60)(see fig. 2, infra).

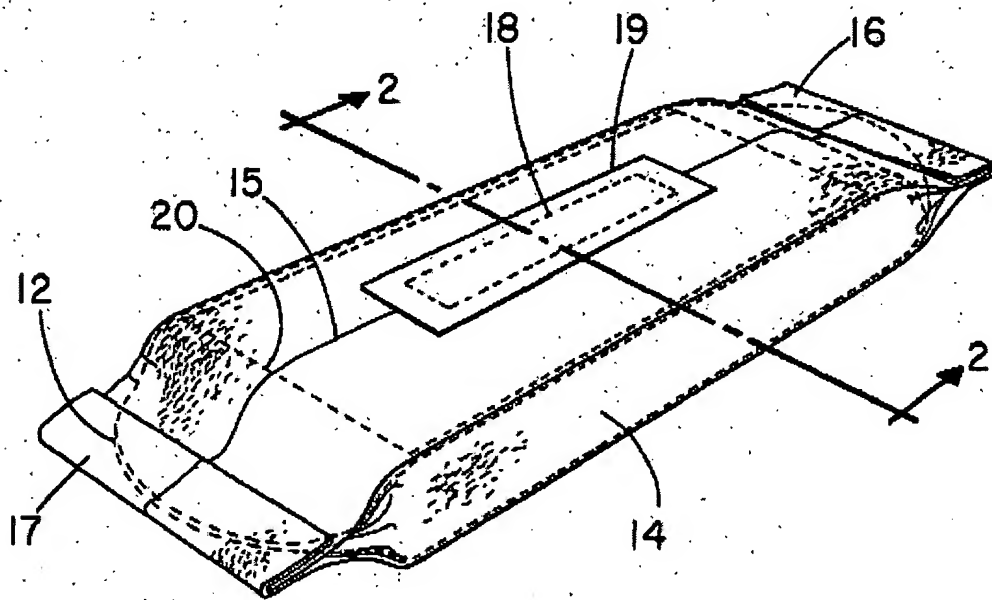


Champaigne, Jr. does not disclose expressly the claimed dimensions for the seam part. Mere changes in relative dimensions are not sufficient to patentably distinguish an invention.

Art Unit: 3761

over the prior art. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Regarding claims 6, 7 and 23, Champaigne, Jr. teaches a lateral seam part (16, 17)(see fig. 1, *infra*). Regarding the functional limitations of the claim, apparatus claims must be structurally distinguishable over the prior art MPEP § 2114. The device of Champaigne, Jr. can be folded in the claimed manner.



Regarding claim 8, Champaigne, Jr. teaches that the back face side sheet (14, 20) is equipped with a mini-sheet (19) on a surface opposite the absorbent body side (see figs. 1 and 2, *supra*).

Regarding claims 9 and 20, Champaigne, Jr. teaches that the back face side sheet (14, 20) is made uneven at least at the surface opposite the absorbent body side (see annotated fig. 2 *infra*). It is noted that the sheet piece is transversely longer than the another sheet piece.

Regarding claim 12, Champaigne, Jr. teaches at least one parting zone formed with the seam part (15) formed by the overlapping of the sheet pieces over one another (see fig. 2, *supra*). Regarding claim 24, Champaigne, Jr. teaches that the back sheet (14, 20) has two sheet pieces (see fig. 2, *supra*).

Regarding claim 24, Champaigne, Jr. teaches a back face sheet (14, 20) including two sheet pieces, see fig. 2, *supra*)

Regarding claim 25, Champaigne, Jr. teaches an adhesive agent (18) applied in a line form (see fig. 1, *supra*):

Regarding claim 26, Champaigne, Jr. does not teach the specific ranges of values for the basis weight of the adhesive. Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

One of ordinary skill in the art would have recognized that increasing the basis weight of adhesive would provide for increased adhesion while slowing dispersion in water.

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Champaigne, Jr. as applied to claims 1, 6-9, 12, 20 and 23-26 above, and further in view of Osborn, III (WO 99/26573 A1; hereinafter "Osborn").

Champaigne, Jr. does not disclose expressly the packaging sheet.

Osborn teaches a packaging body (50) for a sanitary pad (20),
comprising:

a packaging sheet (68); and

a sanitary pad (20) covered by the packaging sheet (68);

wherein the packaging sheet (68) is provided with a continuous or discontinuous parting zone that is parted by actions of water, along which the packaging sheet (68) is separated into a plurality of small sheet piece when water after the packaging sheet is discarded in the toilet (page 19, line 20-page 21, line 23)(see fig. 5).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the packaging of Osborn to package the pad of Champaigne, Jr. in order to provide packaging that is known in the art to be suitable for that purpose.

Regarding the functional limitations, e.g., how the back side sheet disperses after placement in a toilet, apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114. Osborn discloses packaging that can optionally be constructed of a dissolvable material. Even if the packaging is not torn open, it will eventually dissolve, even if this not an intended use of the disclosure.

Art Unit: 3761

Regarding claim 11, Osborn teaches that the packaging sheet is a liquid impermeable sheet (e.g., thermoplastic film) with an impermeable property against liquid (page 19, lines 20-31).

Response to Arguments

Applicant's arguments with respect to claims 1, 6-12, 20 and 23-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Application/Control Number: 10/782,385

Page 9

Art Unit: 3761

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart
29 November 2006

TATYANA ZALUKAEVA
SUPERVISORY EXAMINER

